

and that the article is adapted for mounting upon a wall. The Examiner acknowledges that Travis does not teach the enlarged photograph as part of a flooring surface.

The teaching of Travis involves providing a wall ornament that will withstand the moisture and water environment of a bathtub enclosure, and specifies using "a special moisture proof, water resistant ink upon a sheet 19 of synthetic paper." Col. 2, lines 8-10. The specification further states that the synthetic sheet "is non-absorbent and highly impervious against penetration by ink, water or other fluids" and "provides a suitable substrate for imprinting thereon a graphic illustration by off-set printing, silkscreen printing or lithography." Col. 2, lines 12-16. Travis also mentions in passing that "there may be a top coating of nitrocellulose lacquer or a urethan coating applied to the imprinted sheet to provide a sheet which is scratch and scuff resistant." Col. 3, lines 1-4.

The Examiner's rejection is based on the proposition that "it would be obvious to one of an ordinary skill in the art to use Travis enlarged photograph of any graphic design as flooring surface because of the way it is constructed." The rejection is further based on the proposition that "the skilled person would be motivated to construct the same article from the disclosure of Travis or modify the materials for strength depending on the intended use and use the product as part of a floor tile or floor covering." The Examiner also noted that "since the product of the reference is hard and moisture and scuff resistant it would work in

the same way as applicant's claimed invention."

It is respectfully submitted that the teaching of Travis does not render the claimed invention obvious and that the Examiner's rejection under 103 should be withdrawn.

The claims of the present invention are directed to the combination of a floor tile or flooring surface with an enlarged photographic print or print of photographic quality. There is no teaching or suggestion in Travis to make such a combination. The law is clear that to sustain a finding of obviousness, "there must be some teaching, suggestion, or incentive [in the prior art] to make the combination by the inventor." Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931 (Fed. Cir. 1990). Something in the prior art must suggest the desirability, and thus the obviousness, of making the combination. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051 (Fed. Cir. 1988).

While acknowledging that Travis does not teach the use of an enlarged photographic print as a floor tile, the Examiner states that it would be obvious to use the article in Travis as a floor tile because of the way it is constructed. The construction of the waterproof wall ornament in Travis does not suggest that it be used as a floor tile. Travis specifies the use of moisture proof ink and imprinting "with a special moisture proof, water resistant ink upon a sheet 19 of a synthetic paper." Col. 2, lines 8-10. The specification further states that the synthetic sheet "is non-absorbent and highly impervious against penetration by ink, water or other fluids" and "provides a suitable substrate for imprinting

thereon a graphic illustration by off-set printing, silkscreen printing or lithography." Col. 2, lines 12-16. It is clear from the specification that the wall ornament is specifically adapted for use in a moisture-filled environment and that the article is designed to withstand moisture penetration. There is no teaching or suggestion of any kind to use the article as part of a floor tile or flooring surface or to use the article anywhere other than as a wall ornament in a moisture-filled environment, and it therefore would not be obvious to use the article outside of a moisture-filled environment or outside of a wall ornament.

Moreover, Travis mentions in passing that "there may be a top coating of nitrocellulose lacquer or a urethane coating applied to the imprinted sheet to provide a sheet which is scratch and scuff resistant." In the context of Travis' disclosure, the lacquer or urethane coating would be used to prevent scuffs or scratches that may result in the bathtub enclosure. However, there is no teaching or suggestion that the lacquer or urethane coating could be used as part of a floor tile to form a barrier that prevents injury to the photographic print from foot traffic or other objects passing over the floor, nor is it apparent that the article in Travis could even be used as a floor tile. Simply because a wall-mounted waterproof graphic print has a coating to prevent scratches and scuffs in a bathtub does not render obvious the combination of a floor tile or flooring surface with an enlarged photographic print having a barrier to prevent injury from foot traffic. Even if Travis could be used as part of a floor

tile, to sustain an obvious rejection, there must be a teaching or suggestion in Travis to use the graphic print as a floor tile. As Federal Circuit authority establishes:

Obviousness is tested by what the combined teachings of the references would have suggested to those of ordinary skill in the art. But it cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. And teachings of references can be combined only if there is some suggestion or incentive to do so.

In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

The Examiner acknowledges that there is no teaching in Travis to use the enlarged print as a floor tile, and Applicant respectfully submits that there is also no suggestion to use the print in Travis as a floor tile. The Examiner has pointed to no suggestion in Travis to use the enlarged print in combination with a floor tile or flooring surface.

The rejection is also based on the proposition that "the skilled person would be motivated to construct the same article from the disclosure of Travis or modify the materials for strength depending on the intended use and use the product as part of a floor tile or floor covering." However, there is simply no teaching, suggestion, or motivation anywhere in Travis to combine a floor tile or flooring surface with an enlarged photographic print. Applicant respectfully submits, that this ground of rejection is based on improper hindsight reconstruction. Again the law is clear, the obviousness determination must be made at the time the invention was made and the applicant's disclosure may not be used as a guide to combine the prior art to come up with the

claimed invention. In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (it is essential that the Examiner forget what he has been taught about the claimed invention by the inventor). It should also be noted that it is irrelevant that all elements of an invention may have been old, as virtually all inventions are combinations of old elements. Environmental Designs, Ltd. v. Union Oil Co. of California, 713 F.2d 693, 698 (Fed. Cir. 1983).

Essentially, the Examiner has assumed the existence of the claimed combination and stated that it would be obvious to use the article of Travis as part of the claimed combination. However, this rationale fails to recognize that to support an obviousness rejection, Travis must itself suggest the combination. However, there is no teaching or suggestion in Travis of the combination of a floor tile or flooring surface with an enlarged photographic print.

Furthermore, the Examiner's suggestion that Travis could be modified to produce the claimed invention is insufficient to sustain an obviousness rejection unless Travis suggested the desirability of the modification, which it does not. In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989) ("the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification"), quoting, In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984). Since the Examiner has not provided the necessary suggestion or motivation to modify Travis to produce the claimed invention, the rejection under 103 should be withdrawn.

Claim 1 has been amended to delete the second occurrence of the word "to." Claims 26, 28-31 have been amended to further define applicant's invention. With respect to claim 26, there is no suggestion in Travis to use the enlarged photographic print as part of a commercial merchandising display. With respect to claims 28-31, there is no suggestion in Travis to use the floor tile in a commercial merchandising display to depict a company logo, a retail product, a ground terrain, or a floor covering.

In sum, because there is no suggestion in Travis to combine a floor tile or flooring surface with an enlarged photographic print, it is respectfully submitted that the obviousness rejection based on Travis is insufficient as a matter of law. Accordingly, Applicant has overcome the Examiner's rejections. The application is therefore in condition for allowance and early notice to this effect is earnestly solicited.

If, for any reason, the Examiner is unable to allow the application on the next Office Action and feels that a telephone conference would be helpful to resolve any remaining issues, the Examiner is respectfully requested to contact the undersigned attorney at (312) 321-4720.

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Respectfully submitted,


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